

REMARKS

Paragraphs 1 and 2 of the Office Action

5 Claims 1-3 and 5-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 5,708,412 to Proulx and U.S. Patent Number 4,282,754 to Provasnik.

It is respectfully submitted to the Examiner that the Examiner has found no teachings within the prior art citations that would lead one to believe that they should or could be combined to form applicant's device. Finding the elements is not enough, there
10 must be motivation to make the combination and that motivation must come from the prior art itself and cannot come from applicant's disclosure.

Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.*
15 Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

20 *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Here the Examiner is combining an in situ device with an external device. Provasnik is a device that "can easily and quickly be attached to and removed from the engine." Column 1, lines 43-45. A further object of the Provasnik device is that it "allows for the measuring the temperature of the
25 engine oil of an automobile engine *without inserting* a temperature sensitive device ... *into the engine oil*." Column 1, lines 56-59 (emphasis added). Proulx includes heat sensors directly attached to and in abutment with the engine and a probe positioning in the coolant fluid. Such a structure is not easy or quick to remove from an engine and requires the insertion of a probe into the coolant. Thus, Provasnik teaches against the
30 methods taught by Proulx and one knowledgeable in the art would therefore be dissuaded from combining their teachings. As stated above, the finding of the elements is not enough without motivation and here we have one system adapted for being positioned adjacent to the engine and one that requires internal probes and abutting sensors. Since these requirements are at odds with each other, there can be no motivation and claims 1

and 6, and all claims depending from claim 1, are believed to be in condition for allowance.

The applicant respectfully requests withdrawal of the rejection.

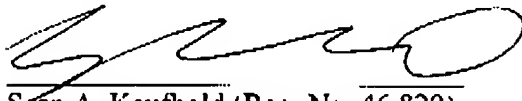
CONCLUSION

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Date: 12/6/05